REMARKS/ARGUMENTS

Claims 1-3, 5-7, 9-11, 16-17 and 22-24 are pending in the present application. Claims 1, 5, 9, 10, 16 and 23 have been amended herewith. Reconsideration of the claims is respectfully requested.

I.   35 U.S.C. § 103, Obviousness

Claims 1-3, 9-11, 16-17 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hackbarth et al. (US Patent No. 7,107,312), hereinafter Hackbarth, and Crawford (US Patent No. 6,781,608). This rejection is respectfully traversed.

With respect to Claim 1, such claim recites features of "responsive to receiving an instant message, determining whether a picture image of a sender of the instant message is associated with the instant message, wherein the picture image of the sender is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system as determined by a user selected preference, and wherein the determining step is automatically performed by an instant messaging process of a receiver of the instant message that determines whether the picture image of the sender is in the local cache or the preexisting database of pictures". There are numerous aspects to these claimed features that are not taught or suggested by any of the cited references, as will now be described in meticulous detail to avoid gloss-over of certain words. This is because per MPEP 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest _all the claim limitations_. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. _In re Vaeck_, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

First, a listing of the features recited in this aspect of Claim 1 is specifically identified to avoid examination 'gloss-over' due to the large number of features recited therein. This aspect of Claim 1 recites:

(1) a determination is made as to whether a _picture image of the _sender_ of the instant image_ is associated with the instant message;

(2) the picture image of the IM sender determination per feature (1) is done _in response to receiving an instant message_;

(3) the location of the picture image of the IM sender is determined by *a user selected preference*; and

(4) the determination that is made with respect to the picture image of the sender of the IM is *automatically performed by an instant messaging process of a receiver* of the instant message.

In rejecting this aspect of Claim 1, the Examiner states that all of the above features (1) - (4) are taught by the cited Hackbarth's "Connecticon View" as described at Hackbarth col. 6, lines 18-40; col. 16, lines 31-44; col. 10, lines 63-67; and col. 5, lines 6-34. Applicants urge numerous errors in such assertion, as follows.

Per Hackbarth's teaching at the cited passage at col. 6, lines 18-40, there Hackbarth states:

> A ConnectIcon View 215 is a virtual entity stating one user's desire to connect to one or more other users. The ConnectIcon View 215 data is stored in the User Agent 203 LDAP database 206 and is made visible in the user's browser in a ConnectIcon View 215. This provides a representation of each other participant's presence status and enables the participants receiving the data to contact each other via clicking. A user configures and sends a ConnectIcon View using servlets of the User Agent 203. **ConnectIcon Views may include pointers to documents, notes, calendars and connection processes such as chat, voice, conference and application sharing.** Specifically, a ConnectIcon View 215 is a dynamic visual representation of the participants of a group being invited to communicate together with their presence information, lists of documents and URLs (Uniform Resource Locators) to be examined, and a set of mechanisms (email, chat, voice, and the like) to initiate communication, each of which can be billed to the originator. The available presence information enables a user to employ the best mode of communicating for the instant purpose, namely, either asynchronous communication or synchronous.

As can be seen, this ConnectIcon view contains (1) a representation of the participants of a group *being invited to communicate together*, (2) presence information (which describes where and how the users are present in the network (col. 5, lines 20-23), (3) lists of documents and URLs to be examined, and (4) a set of mechanisms to initiate communication (including chat). Notably absent in this cited passage is any mention or discussion of any type of a picture image of a sender. Thus, this cited passage does not teach or otherwise suggest any of steps (1) – (4) identified above as they are all specifically directed to sender picture image associated processing. For example, this cited passage does not teach *determining whether a picture image*

of a sender of the instant message is associated with the instant message (feature (1)). It therefore necessarily follows that since feature (1) is not taught, feature (2) is similar not taught because feature (2) is a precursor condition ("responsive to") for performing feature (1), which is missing and therefore feature (2) is also missing. Similarly, this cited passage does not teach "wherein the *picture image of the sender* is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system as determined by a user selected preference" (feature (3)), as there is no mention of a sender picture image in this cited passage. Finally, this cited passage does not teach "wherein the determining step is automatically performed by an instant messaging process of a receiver of the instant message that determines whether the *picture image of the sender* is in the local cache or the preexisting database of pictures" (feature (4)), as there is no mention of a sender picture image in this cited passage. Therefore, it has been conclusively established that the Hackbarth cited passage at col. 6, lines 18-40 does not teach or suggest any of claimed features (1) - (4) identified above.

As to the Hackbarth cited passage at col. 16, lines 31-44, there Hackbarth states:

> The ConnectIcon View 215 gives a list of views of individual ConnectIcon Views, and may be scrolled when the list is large. Each ConnectIcon View is drawn as follows: 1) **An image 905 of each person on the list of recipients** (the person's unique_id is taken from the "people" table 428, and **the image file corresponding to that person is retrieved from a WEB location storing those named files**) is drawn side by side. The image is surrounded by a border 907 that encodes the presence data for that person. In this example implementation, the border is drawn with a color that encodes the most recent device information we have for that person using the same color system as in the PeopleView 419.

While this passage makes mention of a person's image and an image file corresponding to the person, the particular operations associated with an image and image file are substantially different from what is recited in claimed features (1) – (4). This cited passage merely describes the display of multiple images *for each person on a list of recipients*, and that image files are *retrieved from a Web location*. This cited passage does not teach or otherwise suggest *determining whether a picture image of a sender of the instant message* is associated with the instant message (feature (1)). Instead, a plurality of *recipients* (and not a *sender* of an IM message) is displayed per these Hackbarth teachings. It therefore necessarily follows that since feature (1) is not taught, feature (2) is similar not taught because feature (2) is a precursor condition ("responsive to") for performing feature (1), which is missing and therefore feature (2) is also missing. Similarly, this cited passage does not teach "wherein the *picture image of the sender* is located in at least one of a local cache on the data processing system and a preexisting

database of pictures on a remote data processing system *as determined by a user selected preference*" (feature (3)). The cited passage is silent as how the determination is made as to where the images are located, and it certainly does not teach *a user selected preference* is used for such determination (as per feature (3)). Finally, this cited passage does not teach "wherein the determining step is *automatically performed by an instant messaging process of a receiver* of the instant message that determines whether the *picture image of the sender* is in the local cache or the preexisting database of pictures" (feature (4)). This is because these displayed images are used *to initiate an IM session according to a selected image*, as described by Hackbarth at col. 16, lines 45-56. There, Hackbarth states:

> 2) Under the set of images, the message 901 of the ConnectIcon View is drawn as a caption 906. The tooltips technique described above is used to show details on the presence data associated with each person, so that when the mouse 907 is moved over a person's image 905, presence details 908 are drawn on the display. **Clicking on a user's image invokes a menu allowing group or individual mail, conference calls or chat sessions to be *initiated*.** Also any WEB documents associated with the ConnectIcon View are listed and may be loaded into the browser by selecting that option. Another menu option allows the ConnectIcon View to be deleted.

Thus, these images are used to initiate a chat session, and this cited reference does not teach or suggest that a picture image location determination is automatically performed by *an instant messaging process of a receiver of the instant message* because **the image has already been retrieved prior to when the instant message session is even initiated**, and therefore the location of such images is already known prior to the IM session even being initiated. Therefore, it has been conclusively established that the Hackbarth cited passage at col. 16, lines 31-44 does not teach or suggest any of claimed features (1) - (4) identified above.

As to the Hackbarth cited passage at col. 10, lines 63-67, there Hackbarth states:

> `GetImage` is called to retrieve an image of the user. This image is stored in the table `people` as an extra column. In this example implementation the images are stored as raw data defining a JPEG image and are retrieved and stored as standard Java Image objects.

This cited passage describes particular details associated with how an image is actually stored (in an extra column of a table, and that a particular routine (GetImage) is called to retrieve an image). This cited passage does not teach *determining whether a picture image of a sender of the instant message* is associated with the instant message (feature (1)). It therefore necessarily follows that since feature (1) is not taught, feature (2) is similar not taught because feature (2) is a precursor condition ("responsive to") for performing feature (1), which is missing and therefore feature (2)

is also missing. Similarly, this cited passage does not teach "wherein the *picture image of the sender* is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*" (feature (3)), as there is no mention of any user selected preference associated with a sender picture image. Finally, this cited passage does not teach "wherein the determining step is *automatically performed by an instant messaging process of a receiver* of the instant message that determines whether the *picture image of the sender* is in the local cache or the preexisting database of pictures" (feature (4)). Again, this cited passage merely describes details of a database itself, and an ability to access it using a special routine (GetImage). There is no description of operations associated with the actual receipt of an instant message or processing thereof by an instant messaging process. Therefore, it has been conclusively established that the Hackbarth cited passage at col. 10, lines 63-67 does not teach or suggest any of claimed features (1) - (4) identified above.

As to the Hackbarth cited passage at col. 10, lines 63-67, there Hackbarth states:

> User Agent 203 is central to the provision of collaborative services. User Agent 203 is responsible for maintaining presence data, i.e., information, for the registered clients. It maintains lists of subscribers and notifies subscribers of changes in status. The User Agent 203 maintains a LDAP database 206 in which presence information is maintained for each individual registered with the system. It also supports Presence Clients that register with it. These clients include TeamPortal View 214, ConnectIcon View 215, and OpenChannel View 217. **Presence Clients are Java classes that run remotely and can both report changes in presence status and react to User Agent messages telling them that the Presence information has changed for a user they have defined as being in their awareness set.**
>
> **Briefly, the User Agent 203 is a WEB interface to a database that stores information, i.e., presence information, on users that describes where and how the users are present in the network. This information can be used to indicate availability and the best way to contact, i.e., the best mode of communicating with, a user.** Access to presence information is restricted based on user preferences that are stored in the User Agent 203. The User Agent 203 uses a LDAP database 206 to store the data, but direct access to the database is not necessary. Servlets in the User Agent 203 are used to request that presence data be created or changed and to request data or subscribe to presence data (a subscription to presence data means that the subscriber is notified when that data changes).

As can be seen, this passage is directed to a description of "presence data" that is used to indicate *user availability* and the *best mode of communicating* with a user. Notably absent in this cited passage is any mention or discussion of any type of user image. Thus, this cited passage does not teach or otherwise suggest any of steps (1) – (4) identified above as there are all specifically

directed to sender picture image associated processing. For example, this cited passage does not teach *determining whether a picture image of a sender of the instant message* is associated with the instant message (feature (1)). It therefore necessarily follows that since feature (1) is not taught, feature (2) is similar not taught because feature (2) is a precursor condition ("responsive to") for performing feature (1), which is missing and therefore feature (2) is also missing. Similarly, this cited passage does not teach "wherein the *picture image of the sender* is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system as determined by a user selected preference" (feature (3)), as there is no mention of a sender picture image in this cited passage. Finally, this cited passage does not teach "wherein the determining step is automatically performed by an instant messaging process of a receiver of the instant message that determines whether the *picture image of the sender* is in the local cache or the preexisting database of pictures" (feature (4)), as there is no mention of a sender picture image in this cited passage. Therefore, it has been conclusively established that the Hackbarth cited passage at col. 5, lines 6-34 does not teach or suggest any of claimed features (1) - (4) identified above.

Accordingly, as it has been shown in detail that none of features (1) – (4) are taught in any of the four cited Hackbarth passages used in rejecting this aspect of Claim 1 (col. 6, lines 18-40; col. 15, lines 31-44; col. 10, lines 63-67; and col. 5, lines 6-34, as per page 2 of the present Office Action dated 4/16/2007), and none of the other cited references are relied upon as teaching this aspect of Claim 1. Thus, the Examiner has failed to properly establish a prima facie showing of obviousness in accordance with the requirements of MPEP 2143. Accordingly, the burden has not shifted to Applicants to rebut the obviousness assertion[1]. Therefore, Claims 1-3, 9-11, 16-17 and 22 have been erroneously rejected by the Examiner under 35 U.S.C. § 103[2].

Nor do the features described in the cited Crawford reference overcome the above described missing claimed features (1) – (4), at least for the reasons previously provided by Applicants in their response filed January 24, 2007 (and which is hereby incorporated by reference).

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[1] In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

[2] If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Therefore, the rejection of Claims 1-3, 9-11, 16-17 and 22 under 35 U.S.C. § 103 has been overcome.

II.   35 U.S.C. § 103, Obviousness

Claims 5-7 and 23-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hackbarth, Crawford and Rosenblatt et al. (US Publication No. 2002/0007276), hereinafter Rosenblatt. This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claims 5-7 and 23-24 for certain reasons given above with respect to Claim 1, as the newly cited Rosenblatt does not overcome the teaching/suggestion deficiencies regarding features (1) – (2).

Further regarding Claim 5, such claim recites "displaying the picture image of the sender with the instant message on a display in the data processing system if the picture image of the sender is associated with the instant message, wherein the picture image of the sender is embedded by an instant messaging process of the sender into the instant message prior to sending the instant message to the data processing system, and wherein the picture image of the sender is a selected picture that is selected from a plurality of different picture images of the sender, the selected picture being automatically selected by the instant messaging process based upon particular content in the instant message, wherein the picture image of the sender is a mug shot of the sender". First, a listing of the features recited in this aspect of Claim 5 is specifically identified to avoid examination 'gloss-over' due to the large number of features recited therein. This aspect of Claim 5 recites:

(b1) the picture image of the sender is *embedded by an instant message process of the sender* into the instant message prior to sending the instant message;

(b2) the picture image of the sender is selected from a *plurality of different picture images of the sender*; and

(b3) the selected picture is *automatically selected by the instant messaging process* based upon particular content in the instant message.

In rejecting this aspect of Claim 5, the Examiner states:

> "However, Hackbarth fails to explicitly teach displaying the picture image of the sender with the instant message on a display in the data processing system if the picture image of the sendor is associated with the instant message.

> Crawford teaches the use of instant message communication similar to that of Hackbarth. Furthermore, Crawford teaches displaying a picture image of the sender with an instant message on a display in a data processing system if the picture image of the sender is associated with the instant message, as each user of the instant messaging system has a related "buddy icon" that is displayed concurrently with the instant message, as can be seen in Fig. 11, at col. 17, lines 32-38.

> ...

> Hackbarth and Crawford fail to explicitly teach the selected picture being automatically selected by the instant message process based upon particular content in the instant message.

> Rosenblatt teaches the use of an instant message system similar to that of Hackbarth and Crawford. Furthermore, Rosenblatt teaches a selected picture being automatically selected by the instant messaging process based upon particular content in the instant message, as the visual representation of the user is capable of changing its displayed "emotion" based on textual input, at paragraph 0015."

In the above articulated reasons given by the Examiner in rejecting Claim 5, the Examiner has failed to address particular features specifically recited in Claim 5 – in particular features (b1) – (b2) identified above. Thus, the Examiner has failed to properly establish a prima facie showing of obviousness in accordance with the requirements of MPEP 2143. Accordingly, the burden has not shifted to Applicants to rebut the obviousness assertion. Therefore, Claims 1-3, 9-11, 16-17 and 22 have been erroneously rejected by the Examiner under 35 U.S.C. § 103.

This failure to address these claimed features (b1) – (b2) is likely because the cited references do not in fact teach or suggest these claimed features (b1) – (b2) (and as further shown below, the references also do not in fact teach/suggest feature (b3). For example, per the embedded aspect of feature (b1), the

picture image of the sender is *embedded by an instant message process of the sender* into the instant message prior to sending the instant message. None of the cited references teach or suggest such picture image of the sender being embedded by an instant message process of the sender. For example, the newly cited Rosenblatt does not teach an instant message process at all, but instead teaches customized modules – including an authoring module and a player module – that are used to create customized voice that is unilaterally spoken by a virtualized speaker (i.e. it is not a two-way instant messaging system), as described at paragraph 0015. Instead, Rosenblatt is directed to one-way animated applications for web pages, email and PC games (paragraph 0010), which are not a real-time two-way message exchange as is an instant messaging system. The cited Crawford reference does not teach any type of picture image of a sender, and thus cannot teach any embedding of such (missing) picture image of a sender. The Hackbarth reference describes using images to *initiate the instant message session itself* (col. 16, lines 45-57), but does not teach or otherwise suggest that the picture image of the sender is *embedded by an instant message process of the sender* into the instant message prior to sending the instant message. Thus, in addition to the Examiner's failure to properly establish a prima facie showing of obviousness with respect to Claim 5, it is further shown that Claim 5 has been erroneously rejected as there are specific claimed features (e.g. feature (b1)) that are not taught or suggested by the cited references[3].

Still further regarding Claim 5, and specifically in regards to features (b2) and (b3), such claim recites "wherein the picture image of the sender is a selected picture that is selected from a plurality of different picture images of the sender, the selected picture being automatically selected by the instant messaging process based upon particular content in the instant message", and this is the picture image that is displayed (per other features of Claim 5). In contrast, per the teachings of the cited Rosenblatt (which is being cited as teaching the 'displaying' step), an author manually inserts emotion cues into text which is to be spoken by an animated virtual speaker. For example, as described by Rosenblatt at paragraph 0019:

> [0019] **The text window 12 enables the <u>user</u> to enter and edit text 18 to be voiced by a selected virtual representative and to <u>include basic emotion cues</u> 20 that the selected virtual representative will evoke while conveying the corresponding portion**

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[3] **2143.03 All Claim Limitations Must Be Taught or Suggested**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

of the transmitted text. Available emotion cues, indicated by so-called "emoticons" 22, are provided. The authoring module is also capable of invoking a player module in order to allow a user to preview the performance of the text with the embedded emotion cues by the selected virtual representative in a separate or integrated window 24.

Rosenblatt does not teach or otherwise suggest any type of automated picture selection of a sender that is selected, by an instant message process, from a plurality of different picture images of the sender that is based upon particular content in the instant message. Instead, it teaches a manual approach, as previously described, and such manual approach is not part of an instant message process.

Thus, it is urged that Claim 5 has been erroneously rejected under 35 U.S.C. § 103, as (1) a proper prima facie case of obviousness has not been made by the Examiner (as claimed features (b1) – (b2) were not even addressed by the Examiner in the rejection of Claim 5), and (2) there are several claimed features (features (b1) – (b3)) that are not actually taught or suggested by the cited references.

Applicants initially traverse the rejection of Claims 6 and 7 for reasons given above with respect to Claim 5 (of which Claims 6 and 7 depend upon).

Further with respect to Claim 7, it is urged that none of the cited references teach or suggest the claimed feature of "receiving the picture image of the sender with the instant message". In rejecting Claim 7, the Examiner states that this claimed feature it taught by Crawford in Crawford's Figure 11. Applicants respectfully urge that, to the contrary, Crawford does not teach any type of sender picture image, and therefore it cannot teach any processing steps associated with such (missing) sender picture image, such as receiving a picture image of the sender, as expressly recited in Claim 7. Thus, it is further urged that Claim 7 has been erroneously rejected under 35 U.S.C. § 103 as there are additional claimed features not taught or suggested by the cited references.

With respect to Claim 23 (and dependent Claim 24), such claim is directed to a technique for sending an instant message – i.e. it is the send-side of an instant message system. This claim includes receiving means, selection means and sending means. The selection means particular recites "selection means for selecting a picture image of the sender that is to be sent with the instant message, wherein the picture image of the sender is located in a preexisting database of different pictures of the sender and is automatically selected without user intervention by the selection means based upon particular content in the instant message". None of the cited references teach such automatic selection of a sender's picture image as being a part of an instant

messaging process, for similar reasons to those given above with respect to missing claimed features (b1) – (b3) of Claim 5.

Therefore, the rejection of Claims 5-7 and 23-24 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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